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### FAX COVER SHEET

**FAX RECEIVED**

To: Assistant Commissioner for Patents

NOV 13 2000

Attn: \_\_\_\_\_

GROUP 3700

From: M. Arthur Auslander, 18,376

Date: November 13, 2000

Re: Serial No. 09/204,073 Filed April 19, 1999  
 Applicant : Suk-song Oh For Endodontic Gutta-Percha Point  
 With Working Length Marks

No. of pages including cover sheet: 13

### Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile  
 transmitted to the Patent and Trademark Office on the  
 date shown below:

Name : *Reysa Oker*

November 13, 2000

Signature: \_\_\_\_\_

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

FAX RECEIVED

Applicant : Suk-song Oh  
Serial No. : 09/204,073  
Filed : April 19, 1999  
For : Endodontic Gutta-Percha Point  
With Working Length Marks

NOV 13 2000

GROUP 3700

Examiner John J. Wilson  
Art Unit 3732  
Docket No. 3598-6

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

Enclosed are the Notice of Abandonment, amendment, request for one month extension, certificate of mailing, fee transmittal form and post card stamped by the Patent and Trademark Office Mail Room on June 29, 2000 for the receipt of the afore-mentioned papers. The amendment was due on June 13, 2000, responsive to the Office action of March 13, 2000.

The request for extension and authorization to pay the required fee and the enclosed papers should show the timely filing of the responsive amendment for this case.


It is respectfully requested that the notice to abandon be canceled and the within application be put in condition for examination of the proffered amendment.

If there are any fees, they should be taken from applicant's attorney's deposit account No. 01-2940.

Any questions can be directed to applicant's attorney at  
212-594-6900.

Dated: November 13, 2000

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "M. Arthur Auslander", written over a horizontal line.

M. Arthur Auslander  
Auslander & Thomas  
Attorneys for Applicant  
505 Eighth Avenue  
New York, NY 10018  
212-594-6900

Received U.S. Patent and Trademark Office -  
amendment, extension request for one month and  
authorization to take fee from deposit account No.  
01-2940 - Serial No. 09/294,073, Suk-song Oh,  
Gutta-Percha



**Notice of Abandonment**Application No.  
09/294,073

Applicant(s)

Oh

Examiner

John J. Wilson

Group Art Unit  
3732

This application is abandoned in view of:

- ☒ applicant's failure to timely file a proper response to the Office letter mailed on Mar 13, 2000.
- ☐ A response (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_, which is after the expiration of the period for response (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
- ☐ A proposed response was received on \_\_\_\_\_, but it does not constitute a proper response to the final rejection.  
(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC)).
- ☒ No response has been received.
- ☐ applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
- ☐ The issue fee (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_.
- ☐ The submitted issue fee of \$\_\_\_\_\_ is insufficient. The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_.
- ☐ The issue fee has not been received.
- ☐ applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
- ☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of \_\_\_\_\_) were received on \_\_\_\_\_.
- ☐ The proposed new formal drawings filed \_\_\_\_\_ are not acceptable.
- ☐ No proposed new formal drawings have been received.
- ☐ the express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on \_\_\_\_\_.
- ☐ the letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ the letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
- ☐ the decision by the Board of Patent Appeals and Interferences rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ the reason(s) below:

John J. Wilson  
Primary Examiner

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# FEE TRANSMITTAL

Patent fees are subject to annual revision on October 1.  
 These are the fees effective October 1, 1997.  
 Small Entity payments must be supported by a small entity statement,  
 otherwise large entity fees must be paid. See Forms PTO/SB-09-12.  
 See 37 C.F.R. §§ 1.27 and 1.28.

TOTAL AMOUNT OF PAYMENT (\$) 55.00

## Complete If Known

Application Number 09/294,073  
 Filing Date April 19, 1999  
 First Named Inventor Suk-song Oh  
 Examiner Name John J. Wilson  
 Group / Art Unit 3732  
 Attorney Docket No. 3598-6

## METHOD OF PAYMENT (check one)

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit  
 Account  
 Number  
 Deposit  
 Account  
 Name

01-2940

Auslander & Thomas

☒ Charge Any Additional  
 Fee Required Under  
 37 C.F.R. §§ 1.16 and 1.17

☐ Charge the Issue Fee Set in  
 37 C.F.R. § 1.18 at the Mailing  
 of the Notice of Allowance

2. ☐ Payment Enclosed:

☐ Check ☐ Money Order ☐ Other

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
101 780	201 395	Utility filing fee	
106 330	206 165	Design filing fee	
107 540	207 270	Plant filing fee	
108 780	208 395	Reissue filing fee	
114 150	214 75	Provisional filing fee	
SUBTOTAL (1) (\$)			

### 2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	- 20 =	X	
Multiple Dependent	- 3 =	X	

\*or number previously paid, if greater, For Reissues, see below

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
103 22	203 11	Claims in excess of 20
102 82	202 41	Independent claims in excess of 3
104 270	204 136	Multiple dependent claim, if not paid
109 82	209 41	Reissue independent claims over original patent
110 22	210 11	Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
105 130	205 65	Surcharge - late filing fee or oath	
127 50	227 25	Surcharge - late provisional filing fee or cover sheet	
139 130	139 130	Non-English specification	
147 2,520	147 2,520	For filing a request for reexamination	
112 920*	112 920*	Requesting publication of SIR prior to Examiner action	
113 1,840*	113 1,840*	Requesting publication of SIR after Examiner action	
115 110	215 55	Extension for reply within first month	55
116 400	216 200	Extension for reply within second month	
117 950	217 475	Extension for reply within third month	
118 1,510	218 755	Extension for reply within fourth month	
126 2,080	226 1,030	Extension for reply within fifth month	
119 310	219 155	Notice of Appeal	
120 310	220 155	Filing a brief in support of an appeal	
121 270	221 135	Request for oral hearing	
138 1,510	138 1,510	Petition to institute a public use proceeding	
140 110	240 55	Petition to revive - unavoidable	
141 1,320	241 660	Petition to revive - unintentional	
142 1,320	242 660	Utility issue fee (or reissue)	
143 450	243 225	Design issue fee	
144 670	244 335	Plant issue fee	
122 130	122 130	Petitions to the Commissioner	
123 50	123 50	Petitions related to provisional applications	
128 240	128 240	Submission of Information Disclosure Stmt	
581 40	581 40	Recording each patent assignment per property (times number of properties)	
148 790	248 395	Filing a submission after final rejection (37 CFR 1.129(a))	
149 790	249 395	For each additional invention to be examined (37 CFR 1.129(b))	
Other fee (specify)			
Other fee (specify)			

\* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 55.00

## SUBMITTED BY

Typed or  
 Printed Name

M. Arthur Auslander

Signature

*M. Arthur Auslander*

Date

6/27/00

## Complete (if applicable)

Reg. Number

18,376

Deposit Account  
 User ID

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Suk-song Oh  
Serial No. : 09/204,073  
Filed : April 19, 1999  
For : Endodontic Gutta-Percha Point  
With Working Length Marks

Examiner John J. Wilson  
Art Unit 3732  
Docket No. 3598-6

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

## AMENDMENT

Responsive to the Office action dated March 13, 2000, a request for a one-month extension for which is being simultaneously submitted, please amend the within application as follows:

## IN THE CLAIMS

Cancel claim 1 without prejudice and substitute therefor new claim 7 as follows:

1. A gutta-percha point used as a root canal plugging material in an endodontic treatment, said plugging point including a plurality of integral working length marks along an upper portion of said point, said marks spaced apart from each other.

( Cancel claims 4 and 5 without prejudice and substitute therefor new claims 8, 9, 10 as follows: )

2/8. The gutta-percha point according to claim 1 wherein said working length marks include distinguishable colors.

3/9. The gutta-percha point according to claim 8 wherein said working length marks are along a circumferential surface of said point.

4/10. The gutta-percha point according to claim 7 wherein said working length marks are painted.

Cancel claim 6 without prejudice and substitute therefor new claim 11 as follows.

5/11. The gutta-percha point according to claim 1 wherein said working length marks start at a position starting from an apex of said point by 18 mm and ending at a position spaced apart from said apex by 22 mm.

Cancel claim 2 without prejudice and substitute therefor new claim 12 as follows.

6/12. The gutta-percha point according to claim 1 wherein said working length marks are embossed.

Cancel claim 3 without prejudice and substitute therefor new claim 13 as follows:

7/13. The gutta-percha point according to claim 1 wherein said working length marks are engraved.

#### REMARKS

The present invention is an endodontic gutta-percha point with working length marks, wherein the marked gutta percha point

itself is used as the plugging material, as distinguished from just the use of gutta-percha for plugging.

THERE IS NO PRIOR ART OF A GUTTA-PERCHA  
POINT WITH WORK LENGTH MARKS  
USED AS A PLUGGING MATERIAL

The art of using gutta-percha points for plugging is well know, particularly as set forth in Figs. 1 through 3g.

Figs. 1 through 3g describe the difficult and laborious practices of the prior art. The cited art is cumulative of the complex procedures of the root canal techniques prior to the present invention.

Siegel of 1928 provides an over 70 year history of gutta-percha points, which have not provided a marked gutta-percha point plugging material of the present invention.

Original claims 1-6, with their dependencies and multiple dependencies, have now been canceled and new claims 7-13 have been substitute therefor, maintaining their substance in understandable dependencies and better defining the marked gutta-percha point with working length marks, used as a root canal plugging material in endodontic treatment.

New claim 7 now clealy claims the new gutta-percha point as intrinsicly including a selection of work length marks in a gutta-percha point, which in itself, serves as the plugging material.

The prior art is replete with art on the use of gutta percha

for plugging and gutta-percha points, and non gutta-percha points. The prior art is demonstrative in showing the lack of obviousness in the prior art, where separate files and measuring devices were laboriously used recently, in order to measure and then effectuate the root canal plugging. Siegel's 1928 application for a gutta-percha point makes clear that the structure of gutta-percha plugging material point with working length marks of the present invention today is new and unobvious.

Cohan from 1976, while dealing with color coding in dental instruments, neither shows nor suggests the single work length marking plugging gutta-percha point for endodontic treatment. Malmin's plugs, particularly as shown in Figs. 9 through 11, are demonstrative of 34 years of unobviousness in 1972, after the Siegel plug without approaching the gutta-percha work length marked plug point of the present invention.

The cited art teaches away from a nexus for combining Harrison III, a dental cleaning device with Malmin. The amendment to claims 1-6, is set forth in their proper dependencies now in new claims 7-13.

New claim 11 does not claim any novelty in the reality selected dimensions of 18 to 24 mm, but serves as a limitation with regard to new claim 7, upon which it is dependent.

The marking system of Johnson neither shows nor suggests a nexus for structurally combining in gutta-percha point used a

root canal plugging material.

Claim 12, which claims embossing, is dependent upon new claim 7, is distinct over the prior art.

Claim 9, which is limited on a circumferential working length, as shown in Cohan, is now dependent upon new claim 7. Cohan neither shows nor suggests a gutta-percha point used as a root canal plugging material, nor is there is any nexus shown for the connecting of Cohan, a gutta-percha point used as a root canal plugging material in an endodontic treatment. This further holds true with regard to amended claims 9 and 10, which are dependent upon allowable claim 7 and which include limitations of circumferential markings and paint. No novelty, per se, is claimed in the use of circumferential markings, nor paint.

Claims 7-13, as now amended, and put in proper dependent form, are now allowable with claims 8-13, at least allowable as dependent upon independent claim 7, as now amended.

The difficulties in terms of language translation, have now been thoroughly overcome by the claims as amended and also considered in terms of the Remarks herein.

In view of the amendment to the claims, the within application is deemed in condition for allowance and prompt allowance is therefore respectfully requested.

If there are any charges with regard to this amendment, they should be taken from applicant's attorney's deposit account No.

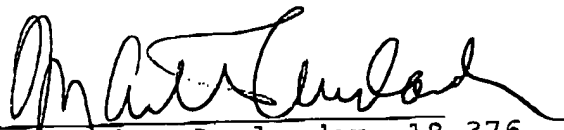
01-2940.

In the event of any difficulty which does not place in condition for allowance, it is respectfully requested that the Examiner call applicant's attorney at 212-594-6900 to discuss any further amendment that might be required to place the case in condition for allowance.

Dated: New York, NY  
June 27, 2000

Respectfully Submitted,

AUSLANDER & THOMAS



M. Arthur Auslander, 18,376  
Attorney for Applicant  
505 Eighth Avenue  
New York, NY 10018  
212-594-6900

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Suk-song Oh  
Serial No. : 09/204,073  
Filed : April 19, 1999  
For : Endodontic Gutta-Percha Point  
With Working Length Marks

Examiner John J. Wilson  
Art Unit 3732  
Docket No. 3598-6

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

## REQUEST FOR AN EXTENSION UNDER RULE 1.136

Applicant, by his attorney, pursuant to Rule 136 of the Rules of Practice in Patent Cases, hereby requests an extension of one month with respect to the Office action dated March 13, 2000, which required response within three months.

The within extension is being made within the first month for response. The extension fee of \$55.00, or any differential thereof, should be taken from applicant's attorneys' deposit account No. 01-2940.

T.H.  
11-27-00  
#4/EF  
Hme  
(HWS)

An extra copy of this request is enclosed.

Dated: New York, NY  
June 27, 2000

Respectfully Submitted,

AUSLANDER & THOMAS

A handwritten signature in cursive script, appearing to read "M. Arthur Auslander".

M. Arthur Auslander, 18,376  
Attorney for Applicant  
505 Eighth Avenue  
New York, NY 10018  
(212) 594-6900

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

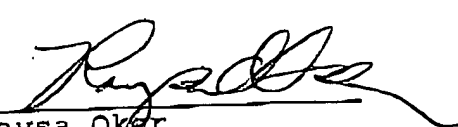
Applicant : Suk-song Oh  
Serial No. : 09/204,073  
Filed : April 19, 1999  
For : Endodontic Gutta-Percha Point  
With Working Length Marks

## CERTIFICATE OF MAILING

I hereby certify that the amendment and request for an extension under Rule 1.136 are being deposited with the United States Patent and Trademark Office, deposited as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on the ~~27~~ day of June, 2000.

AUSLANDER &amp; THOMAS

By

  
Raysa Oker

Dated: June 27, 2000